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Paper No.  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re **Gear International Trading Company**

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Serial No. 75/459,687

Serial No. 75/459,793

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Robert J. Schaap for Gear International Trading Company.

Elissa Garber Kon, Trademark Examining Attorney, Law Office **110**  
(Chris A.F. Pedersen, Managing Attorney).

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Before Quinn, Hairston and Holtzman, Administrative Trademark  
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Gear International Trading Company has filed applications to  
register the marks set forth below. The word HOCKEY has been  
disclaimed in each application.

**Serial No. 75/459,687** for "clothing primarily for roller hockey and ice hockey, namely, pants and hockey shell pants worn about body protective pieces, and jerseys, shirts, and boots."<sup>1</sup>



**Serial No. 75/459,793** for "sporting goods for ice hockey and roller hockey, namely, skates, protective pads for shoulders and elbows, hard shell gloves for hockey, goal keeper pads, blocker mittens, pucks, sticks, balls and hockey skate blades."<sup>2</sup>



In each application, applicant has claimed ownership of Registration No. 2,103,998 for the mark set forth below for "clothing, namely, roller hockey pants, jerseys, t-shirts, sweatshirts and pants" in Class 25; and for "sporting goods for roller hockey, namely, protective shoulder pads, elbow pads, goal keeper pads, skates, catching mitts, goal pads, blocker mitts, roller hockey gloves, pucks, sticks and balls" in Class 28. The registration includes a disclaimer of "GEAR ROLLER HOCKEY."<sup>3</sup>

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<sup>1</sup> Filed March 31, 1998; alleging a bona fide intention to use the mark in commerce.

<sup>2</sup> Filed March 31, 1998; alleging a bona fide intention to use the mark in commerce.

<sup>3</sup> Issued October 7, 1997.



The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act essentially on the ground that the wording in a non-distinctive background design is generic for applicant's ice and roller hockey equipment and clothing; and if not, that the wording in a non-distinctive background design is descriptive of the goods, and that the evidence is insufficient to show that the proposed mark has acquired distinctiveness.

When the refusal in each case was made final, applicant appealed. Briefs have been filed. Applicant filed a request for an oral hearing but the request was later withdrawn. Because the issues in these two applications are substantially the same, the appeals have been consolidated and are being treated in a single decision.<sup>4</sup>

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<sup>4</sup> Applicant is also the owner of four other related applications currently on appeal before the Board, which in view of the additional issues presented by those cases, are being decided in separate opinions. Two of those cases involve the words GEAR ROLLER HOCKEY displayed in what applicant variously refers to as a "mechanical gear" and "toothed round disk" design and the two others involve GEAR in an oval design. The request for an oral hearing, which was subsequently withdrawn, was for a consolidated hearing on all six cases.

As a preliminary matter, we can quickly dispense with an issue in this case which has not been seriously disputed by applicant. The proposed mark in each application consists of the words GEAR HOCKEY displayed against a rectangular background design. The Examining Attorney maintains, as indicated above, that the proposed mark is not registrable because the wording is generic and the background design is not distinctive. Since applicant does not dispute the Examining Attorney's claim that the background design in these cases is not inherently distinctive, and since, in any event, we agree with the Examining Attorney that the design consists of a common geometric shape and that it functions merely as a background carrier for the word portion of the proposed mark, we conclude that the design is not inherently distinctive. See, for example, *In re Raytheon Co.*, 202 USPQ 317 (TTAB 1979) and *American Can Company v. Marcal Paper Mills, Inc.* 152 USPQ 772 (TTAB 1967). In fact, applicant's own evidence shows that a similar rectangle shape is used as a background design by at least one of applicant's competitors on its own hockey equipment.<sup>5</sup>

Thus, the issues are as follows. If we determine that GEAR or GEAR HOCKEY (if we find it to be a unitary phrase) is generic

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<sup>5</sup> See exhibit 4 accompanying the declaration of Dennis Wu, *infra*, which is an advertisement appearing in *Unite* magazine for "Bauer" hockey skates.

for applicant's goods, then the proposed mark will not be entitled to registration on the Principal Register without a showing that at least the background design has acquired distinctiveness for the identified goods, and even then only with a disclaimer of both words. If the wording is not generic but descriptive of the goods, then the mark will not be registrable without a showing of acquired distinctiveness as to the entire mark, or at least the word portion thereof. We note in this regard that applicant is not expressly seeking registration of the mark under Section 2(f) only as to the word portion of the mark. Nevertheless, since a significant portion of applicant's evidence and argument relates solely to that portion of the mark, we will address the issue of whether the word portion of the mark has acquired distinctiveness for applicant's goods.

We turn then to the Examining Attorney's arguments and evidence on these issues. The Examining Attorney contends that GEAR is the generic name for clothing and equipment used in the sports of ice hockey and roller hockey, and that such goods would be understood by the relevant purchasers to be "hockey gear." The Examining Attorney additionally notes that HOCKEY is the common name for the sport of hockey, whether played on ice skates or roller skates, and maintains that the average purchaser of applicant's goods would understand the words, taken together, to refer to "gear for hockey" or "hockey gear." In support of her

position, the Examining Attorney has submitted a dictionary definition of "gear" as meaning

Equipment, such as tools or clothing, used for a particular activity; paraphernalia: fishing gear;...clothing and accessories.<sup>6</sup>

Additional dictionary listings submitted by the Examining Attorney define "gear" as "clothing, garments;...equipment, paraphernalia (fishing gear)"<sup>7</sup> and as "miscellaneous articles needed for a particular operation or sport etc."<sup>8</sup>

In addition, the Examining Attorney has made of record over thirty excerpts of articles from the NEXIS database showing use of "gear" in connection with hockey equipment and related articles of clothing. Representative excerpts are reproduced below (emphasis added).

He grew up watching his dad run a sporting goods store that specialized in repairing **hockey gear** and now he's the owner of Maximum Lacrosse, an equipment-making company he runs from a production plant in surrey, B.C. *The Buffalo News* (February 27, 1999).

"I love the whole idea of being the goalie," she says. "I tell everyone, 'Hey, I'm an ice hockey goalie.' The five-foot Bongen,...doesn't fit the image of a hulking hockey player. Her short stature and size send her to the junior section to buy her **hockey gear**. *The Indianapolis News* (February 25, 1999).

Several players work part-time jobs to help pay for their expensive **roller hockey gear**, which can cost from \$600 to

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<sup>6</sup> *The American Heritage Dictionary of the English Language*, (3<sup>rd</sup> ed. 1992); electronic version.

<sup>7</sup> *Webster Dictionary*, <http://www.m-w.com>, searched December 6, 1999.

<sup>8</sup> *WordNet 1.6* (1997), <http://www.dictionary.com>, searched December 6, 1999.

\$1000. *The Press-Enterprise* (Riverside, CA) February 2, 1999.

HEADLINE: Fan's soccer practice turns into target practice....Now most folks are probably acquainted with the type of protective **gear a hockey goalie wears**: the mask, pads, helmet. Well here's how much protection a goalie in soccer gets: ...A stinking pair of gloves. *The Detroit News* (November 27, 1998).

This year, with some money left over from 1997, the Stewarts are sponsoring junior golf at Franklin Park and paying for all the equipment in a youth **hockey program**, the **gear** to be cleaned and refurbished by the Riddell Co. of Somerville. *The Boston Globe* (July 30, 1998).

Huge equipment bags covered the floor. It takes a lot of **gear** to play **hockey**. Skates are the most expensive item, perhaps \$ 200 for a good pair. Up to \$ 400 to \$ 500 more can be spent on sticks, a helmet, pants, jersey, socks and pads for hips, shoulders, knees, shins and elbows. *St. Petersburg Times* (June 17, 1998).

Expect New York Islanders Mariusz Czerkawaski to be the first man at team events in the future...."I wasn't late," Czerkawaski said. "I just wasn't early enough."....His coach was angry that he was still in street clothes while the rest of the team was in **hockey gear** ready to go. *The Ledger (Lakeland, FL)* (January 31, 1999).

Further, the Examining Attorney has submitted copies of twelve third-party registrations issued on the Supplemental Register, eight of which are for various articles of clothing, and one which is for sporting goods. The word "gear" has been disclaimed in each of these registrations. Two of these registrations are described below.

THE ORIGINAL BASEBALL GEAR is registered for "clothing; namely, knit and woven tops, bottoms, shorts, and nightshirts." The wording BASEBALL GEAR is disclaimed.<sup>9</sup>

EXTRAORDINARY CLIMBING GEAR for "climbing equipment, namely carabiners, slings, belay and rappel devices..." The wording CLIMBING GEAR is disclaimed.<sup>10</sup>

The record also includes fifteen third-party registrations, examples of which follow, for hockey equipment wherein each registrant has used the word "gear" in its identification of goods.

MISSION (owned by Mission Hockey Company Corporation) for hockey equipment, namely, ice, in-line, and roller hockey skates; wheels for in-line or roller skates; protective **gear**, namely, shoulder, knee, shin, hand or elbow pads; mouth guards; and sticks.<sup>11</sup>

NHL ROLLER HOCKEY NATIONAL HOCKEY LEAGUE (and design)(owned by National Hockey League) for in-line roller skates and parts therefor; in-line roller skating **gear**; namely, elbow pads, shin pads, knee pads, protective head **gear**, roller hockey sticks and pucks, goalie masks, and protective gloves.<sup>12</sup>

SHARKS (stylized) (owned by San Jose Sharks LP) for hockey **gear**; namely, ice and street hockey sticks and pucks, hockey gloves, hockey masks and goalie masks; golf accessories; namely golf club head covers, golf balls and golf bags; in-line roller skating **gear**; namely, in-line roller skates, elbow pads, shin pads, knee pads, protective head gear and protective gloves;...<sup>13</sup>

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<sup>9</sup> Registration No. 1,785,041; issued July 27, 1993; Section 8 accepted.

<sup>10</sup> Registration No. 1,914,355; issued August 22, 1995; Section 8 accepted.

<sup>11</sup> Registration No. 2,211,348; issued December 15, 1998.

<sup>12</sup> Registration No. 1,956,733; issued February 13, 1996.

<sup>13</sup> Registration No. 1,796,012; issued September 28, 1993; Sections 8 and 15, accepted and filed, respectively.



Applicant does not dispute the generic meaning of HOCKEY but essentially contends that the word GEAR or the phrase GEAR HOCKEY is suggestive of its goods and that the Office has failed to meet its burden of showing that either GEAR or GEAR HOCKEY is generic or even descriptive of those goods. Applicant states that it primarily sells high-end roller and ice hockey equipment and clothing, and claims that the purchasers of these goods "usually know the equipment and clothing by the name 'Gear' or 'Gear Roller Hockey' or 'Gear Hockey'." (Applicant's brief, p.3). Applicant maintains that there is nothing in the dictionary definitions of "gear" to show that the word is associated with sporting goods used specifically in the sport of hockey. Moreover, the fact that "there are references to a few newspaper articles which refer to the clothing and equipment in the roller hockey field as 'gear'" and that "a few" of applicant's competitors "have attempted to use the 'gear'" (applicant's reply brief, p.6) do not, according to applicant, establish that the term is generic or descriptive for the goods, particularly in light of what applicant considers substantial evidence that the term is not generic or even descriptive of the goods.

Applicant argues alternatively that even if GEAR is deemed merely descriptive of its goods, applicant's evidence is sufficient to show that the term has acquired distinctiveness for

those goods.<sup>14</sup> In support of its claim of acquired distinctiveness and to "refute" the argument that GEAR is generic, applicant has submitted evidence consisting of two declarations (with exhibits) of applicant's president, Dennis Wu; the declarations of four individuals who, according to applicant, are "experts in the field" (applicant's reply brief, p.10); and eight third-party registrations on the Principal Register wherein the word "GEAR" is not disclaimed.

In his initial declaration, Mr. Wu states that applicant first used "the mark identified in our existing trademark registration" in 1995.<sup>15</sup> According to Mr. Wu, the annual sales of equipment "under the 'Gear' related marks" totaled \$78 thousand in 1995; \$1.1 million in 1996; and \$2.2 million in 1997; and the annual promotional expenditures for "gear related marks" totaled \$152 thousand in 1996 and \$168 thousand in 1997.<sup>16</sup>

Mr. Wu also states that "GEAR" has become widely known as the result of, and as evidenced by, its advertisements in trade magazines and newsletters; its sponsorship of a team "[known as

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<sup>14</sup> As we noted earlier, although applicant has not specifically sought registration under Section 2(f) as to the GEAR portion of its mark, we have construed applicant's argument as such.

<sup>15</sup> Mr. Wu is apparently referring to the same registration claimed in the application.

<sup>16</sup> Although it is not at all clear from the declarations themselves, it appears from the accompanying exhibits that "gear related marks" may include the word GEAR alone, the "toothed" design with or without the word GEAR or other wording, the phrase "GEAR ROLLER HOCKEY" with or without an accompanying design, and the phrase "GET INTO GEAR."

Team Gear] that traveled around the country and promoted [applicant's] name and mark"; its sponsorship of professional hockey tournaments, such as the "Anaheim Bull Frogs" in 1998, whose games were shown on ESPN2 and who wear and use applicant's equipment and clothing; the appearance of GEAR equipment in an advertisement by Kryptonics, another sporting goods company; and its promotion of the "GEAR" name on non-sport promotional items.

The exhibits accompanying this declaration include an advertisement appearing in *Unite* magazine by Kryptonics Company, featuring a hockey player in "GEAR" clothing and equipment; advertisements by two of applicant's competitors, Bauer of Canada and Mission of Santa Ana, California, appearing in that magazine; an advertisement by applicant in that same magazine for applicant's hockey equipment and clothing; portions of applicant's product catalog; and product information sheets distributed by applicant at trade shows.<sup>17</sup>

Mr. Wu states in his supplemental declaration that the roller and ice hockey equipment offered by applicant is only sold in "pro shops," that is, "shops dealing with professional end equipment or so-called 'high end' [equipment]." This equipment and clothing, according to Mr. Wu, would typically sell for a

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<sup>17</sup> The exhibits consisting of a photograph of a sponsored team member wearing a "Team Gear" patch and photographs of the "non-sports" promotional items (exhibits 1 and 11) are missing from each of these applications as well as from the files of the four related applications.

much higher cost than equipment found in general sporting goods stores or chains of those stores. Mr. Wu also states that there are only about eight companies which produce high-end roller and ice hockey equipment and clothing, including the Mission and Bauer companies, and that applicant "is no less prominent in the industry than Bauer and Mission." Mr. Wu asserts that "a purchaser of high end roller hockey or ice hockey equipment almost inevitably knows the type of equipment offered merely by knowing the name of the manufacturer." Continuing, Mr. Wu states that

...Gear Roller Hockey is recognized as a company and when one interested in purchasing high end roller hockey or ice hockey equipment asks for this equipment, he or she knows fully well that Gear is the name of a particular company...

Mr. Wu adds that he

[has] spoken with numerous retailers of high end ice hockey and roller hockey equipment and they inform me that essentially no one requests such equipment by use of the term "Gear." People will typically refer to the items used in a game of ice or roller hockey as "equipment" but rarely, if ever, is the term "Gear" ever used to refer to those items. Thus, the people who purchase gear hockey equipment recognize that equipment by virtue of the name "Gear."

Applicant has also submitted four essentially form declarations from Randy Exelby, Ryan Bailey, Nicholas Boyarski, and Theodore Brenner, managers and operators, or former operators, of sporting goods stores located in the Mesa, Tucson or Phoenix areas in Arizona. All four declarants state that they

are aware that applicant "operates under the name of 'Gear Roller Hockey'" and that "Gear Roller Hockey is probably one of the top known names in the field of high end roller and ice hockey equipment" and that "essentially no one in the field of hockey...refers to the equipment as 'gear'." The declarants further assert that "sports enthusiasts typically know[] the equipment manufacturer by name and will frequently ask for a particular brand as, for example, Mission equipment or Gear equipment." Only three of the four declarants state that they are familiar with the purchasing habits and purchasers of ice hockey and roller hockey sporting equipment and clothing, but all four declarants state [essentially] that

People will frequently come into a sporting goods store....They may frequently ask for "hockey equipment", but rarely, if ever, do they ask for "hockey gear" or "gear."

Applicant has also made of record eight third-party registrations on the Principal Register for marks in which the word "GEAR" has not been disclaimed (including GEAR in stylized form for tennis packs and racket bags, registered under Section 2(f); GEAR for Christmas tree ornaments; FAN GEAR for belts and suspenders; FIFTHGEAR and design for footwear; and GET IN GEAR for clothing and footwear). Applicant claims that these registrations show that the Office does not "merely treat the

term 'Gear' as being generic with respect to a line of items in a particular activity."

Applicant contends that "[w]hether or not [the toothed disk] is...part of the mark, the perception of the public as to the meaning of the term 'Gear' is important" and that in this case "the purchasing public perceives...the mark in that fashion." (Applicant's brief, p.20). Applicant maintains that the purchasing public associates the "toothed disk" design with the term GEAR "because of [applicant's] earlier registration" and because applicant has "actively promoted this name and mark 'Gear' in association with the actual design of a gear almost since its very inception." (Applicant's reply brief, p.8).

#### **DECISION**

The test for determining whether a mark is generic involves a two-step inquiry. The first step is to identify the genus (category or class) of goods at issue. The second step is to determine whether the term sought to be registered is understood by the relevant public primarily to refer to that genus (category or class) of goods. See *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) citing *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

The general category of goods in these cases can be described as equipment, including clothing, used for sports

activities. The particular sports activities identified in these applications are forms of hockey, that is, roller hockey and ice hockey. The category of applicant's goods is not limited in these applications to the "high-end" market or to purchasers for those goods.

The question, then, is whether GEAR is generic as applied to those goods. The test for making this determination turns upon how the term is perceived by the relevant public, that is, the primary significance of the term to the relevant public. *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); *In re Recorded Books Inc.*, 42 USPQ2d 1275 (TTAB 1997); and *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443 (TTAB 1994). The relevant public in this case consists of the general consuming public for sports equipment.

The Office has the burden of proving genericness by "clear evidence" of the public's understanding thereof. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the public's understanding of a term may be obtained from any competent source including consumer surveys, dictionary definitions, newspapers and other publications. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 1559, 227 USPQ 961, 963 (Fed. Cir. 1985).

We have considered all the evidence of record bearing on purchaser perception of "gear" including applicant's evidence of

acquired distinctiveness. See *In re Recorded Books Inc.*, supra and *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988). In doing so, we find that the evidence submitted by the Examining Attorney establishes that the primary meaning of "gear" is generic in relation to the identified goods.

To begin with, the dictionary references submitted by the Examining Attorney demonstrate that the word "gear" is essentially interchangeable with the word "equipment" when referring to the paraphernalia, including clothing, which is used in connection with particular sports activities. An additional listing even shows that "gear" is used as a synonym for "equipment."<sup>18</sup> None of the definitions specifically mention "ice hockey" and use, instead, the sport of "fishing" to illustrate a typical use of the word in context, i.e., "fishing gear." Nevertheless, it is obvious that these definitions contemplate the use of "gear" to identify the equipment used for other sports activities as well, including equipment associated with the games of ice hockey and roller hockey. Thus, we agree with the Examining Attorney that when the word "gear" is combined with "hockey," the name of the sport, as in applicant's proposed mark,

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<sup>18</sup> "Equipment -SYN. 1. apparatus, paraphernalia, **gear**,..." (emphasis added). *Webster's Encyclopedic Unabridged Dictionary of the English Language* (1996). The Board can take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), aff'd, 701 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).



purchasers would understand the class or category of goods to be "hockey equipment" or "equipment for hockey."

The third-party registrations submitted by the Examining Attorney for marks incorporating the word GEAR and covering related goods provide further evidence that purchasers would attribute the ordinary dictionary meaning of "gear" to sports equipment and clothing. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976) and *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991) [Third party registrations may be used to show that there is well-known and commonly understood meaning of a word and that a mark has been chosen to convey that meaning.].

Moreover, the NEXIS evidence made of record by the Examining Attorney confirms the generic meaning of "gear" in relation to hockey equipment and clothing. Each article shows use of the word "gear" to designate hockey equipment. In fact, some of the articles use "gear" to refer to the precise items of hockey equipment and clothing, including the mask, pads, and helmet as well as pants, jerseys, and socks, offered by applicant.

Applicant "admits" that there are a "few" newspaper articles referring to the clothing and equipment in the roller hockey field as "gear." Applicant maintains, however, that "these few bits of evidence" do not establish that "gear" is generic. As noted by the Board in *In re Audio Book Club Inc.*,

52 USPQ2d 1042 (TTAB 1999), the use of a term in a generic manner in a variety of general circulation newspapers is a strong indication that the general public views the term as the generic name. In this case, the appearance of "hockey gear" or similar phrases in over thirty NEXIS articles from a variety of news sources cannot be considered just a few aberrant uses of the word "gear" in relation to hockey equipment. The term appears to be used consistently in these articles in the same way the word "equipment" might be used to name these goods. To the extent that applicant is contending that the word "gear" would have to be used in each article in the specific context of ice hockey or roller hockey in order for the evidence to be persuasive, the argument fails. There is no logical reason why the meaning of "gear" for hockey equipment should depend on the nature of the hockey game. In addition, as in surname cases, there is no "magic number" of articles or, in applicant's words, "bits of evidence" which would be required to show that a term is generic.<sup>19</sup> The important consideration is the quality and character of the evidence, that is, whether the evidence of generic usage is "clear." The NEXIS articles in these cases

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<sup>19</sup> Cf. *In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993) ["There is no magic number of listings which is probative to show that a term is primarily merely a surname."] and *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988).

provide clear evidence of generic usage of "gear" in the relevant field.

We note applicant's statement that "where all of your competitors use the same term...within their marks that the mark is obviously generic" and applicant's contention that "this mark is not used by competitors to identify their goods." However, the critical question is not necessarily whether competitors use the same term "within their marks" but whether competitors would use the same term to refer to their goods by name. The fifteen third-party registrations made of record by the Examining Attorney showing that others in the industry, including Mission, one of the very competitors identified by Mr. Wu in his declaration, have used the word "gear" to generically refer to their own hockey equipment. The Office requires that goods be described in the application by their common commercial names and "using terminology which is generally understood" and presumably these registrants have done that. See TMEP § 804.01. This evidence indicates that applicant's direct competitors and others in the field use "gear" as a generic designation for their own hockey equipment and clothing.

By the evidence made of record by the Examining Attorney, the Office has met its burden of proving the genericness of "gear." The evidence clearly demonstrates that the purchasing

public would understand that "gear" identifies the sports equipment itself rather than the source of the equipment.<sup>20</sup> Moreover, we find that applicant's evidence, taken as a whole, fails to show that "gear" is perceived as an indication of source by the relevant public.

With respect to applicant's declarations from individuals "in the field," our concern is not so much with the form of those declarations as with their substance.<sup>21</sup> These individuals are attesting not only to their own perception of "GEAR," but also to the perception of customers, and apparently the entire "hockey industry" as well. To begin with, the asserted references in the declarations to the recognition of "GEAR" as a mark, as opposed to, for example, a company name, are somewhat ambiguous. Nevertheless, to the extent these individuals do claim that "Gear" is recognized as a mark by purchasers and those in the industry, the evidence is not very persuasive. Applicant has failed to establish that these individuals are "experts in the field" and that they are therefore qualified to speak on behalf

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<sup>20</sup> We also note that at least one published case has held the word "gear" to be generic for "clothing." See *Gear Inc. v. L.A. Gear California Inc.*, 670 F.Supp. 508, 4 USPQ2d 1192 (SDNY 1987). The decision and the findings in that case were later vacated by the Court in view of a subsequent settlement agreement of the parties, not as the result of any further fact-finding by the Court.

<sup>21</sup> The fact that these are form declarations does not, in and of itself, render the evidence invalid or unpersuasive. In *re Data Packaging Corp.*, 453 F.2d 1300, 172 USPQ 396 (CCPA 1972) and *In re Benetton Group S.p.A.*, 48 USPQ2d 1214 (TTAB 1998).

of the entire hockey industry, high-end or otherwise. In fact, their experience in the retail field seems somewhat limited and there is no reason to believe that their knowledge of "industry" perception extends beyond the confines of their respective stores. The declarations indicate that Mr. Exelby has owned three sporting goods stores in Phoenix for five years, Mr. Brenner has owned a sporting goods store in Tucson for two years, and Mr. Bailey, currently the manager of a hockey stadium owned by applicant and the owner of a hockey league of "youth teams and adult teams," was the manager of a sporting goods store in Tucson, Arizona for one year. Mr. Boyarski's experience in the field is not revealed. We also note that none of these individuals have even indicated how long they have sold applicant's equipment or, with the exception of Mr. Exelby, whether they ever sold GEAR products in their stores.

In any event, the relevant question in determining genericness is the perception of the mark by purchasers, not that of the industry. In this regard, we have no direct evidence of how the purchasing public would view the designation. We have only these four retailers' claims regarding consumer perception and, to the extent, if any, that these retailers are even qualified to speak for the buying public, their generalized comments are not particularly persuasive. Each declarant seems to claim that the entire universe of relevant purchasers of

hockey products (or high-end hockey products) recognizes GEAR as a mark for those products. This sweeping claim is not credible. Moreover, even assuming that the declarants are only referring to the perception of the customers of their own stores, as opposed to customers in general, the evidence is still not particularly meaningful. It is likely that those customers, and more specifically those customers who allegedly do recognize GEAR as a mark, do not represent a significant portion of the buying public in general.

Thus, these declarations, at best, establish that only a very small number of people recognize GEAR as a mark. The evidence is insufficient to demonstrate that the relevant public in general recognizes GEAR as a mark even if the relevant public is considered to be purchasers of so-called "high end" hockey equipment. See *In re Audio Book Club Inc.*, supra and *In re Recorded Books Inc.*, supra.

We also note these retailers' assertions that "no one" in the field of hockey "refers to the equipment as 'gear'" and that while customers may ask for hockey "equipment," they "rarely, if ever," ask for "hockey gear" or "gear."<sup>22</sup> However, a product may

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<sup>22</sup> We also note Mr. Wu's statement that he "[has] spoken with numerous retailers of high end ice hockey and roller hockey equipment and they inform me that essentially no one requests such equipment by use of the term 'Gear'." Mr. Wu has not identified any of these retailers or whether, for example, they are the same retailers whose declarations are already of record.

have more than one generic name. In re Sun Oil Co., 426 F.2d 401, 165 USPQ 718, 719-720 (CCPA 1970) (Rich, J., concurring) ["Because one merchandiser has latched onto one of the descriptive terms does not mean it can force its competitors to limit themselves to the use of the others.... All of the generic names for a product belong in the public domain." (Emphasis in original)]. Thus, the fact that there may be other generic terms for the goods such as "equipment," or even if the word "equipment" is the more established term for these goods does not overcome the perception of "gear" as an additional generic word for the goods. See S.S. Kresge Co. v. United Factory Outlet, Inc., 598 F.2d 694, 202 USPQ 545 (1st Cir. 1979) ["The question...is not whether a term is more frequently chosen colloquially than any of its synonyms, but whether it still retains its generic meaning."]. Although purchasers may also use other words to ask for these goods, the evidence in this case shows that the relevant public still *understands* that "gear" is a term which refers to this class of goods, even if they would use the term less frequently.

The eight third-party registrations made of record by applicant fail to support its position that "gear" is perceived as a mark. We noted earlier that third-party registrations may be used to show the ordinary dictionary meaning of a term. However, the weight to be given these registrations depends upon,

among other considerations, the nature of the marks therein and whether the goods covered by the registrations are in related fields. If the respective marks and goods are not similar, the registrations will be inadequate to show meaning in connection with the relevant field. One of the registrations identified by applicant is for Christmas tree ornaments, goods which are unrelated to those at issue. The goods in six of the other registrations are arguably related to these goods but the marks in those registrations are not at all similar to the mark in these cases. The use of the word GEAR in different contexts and combined with other wording is not evidence that the word "GEAR" alone is not generic for the identified goods. Moreover, two of those six registrations have been cancelled by the Office and are therefore not evidence of anything. The remaining registration is for the stylized word GEAR for containers for carrying tennis equipment. The mark is registered under Section 2(f) and therefore admittedly descriptive of the registrant's goods.<sup>23</sup> In addition, the existence of a single registration is not persuasive evidence that GEAR is not generic for applicant's goods, nor does it reflect general Office practice with respect to the registrability of this term.

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<sup>23</sup> See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).



In determining whether GEAR is generic we have also considered applicant's evidence of "acquired distinctiveness" including the length of use, volume of sales and advertising expenditures, and applicant's other evidence of public exposure of its "gear related marks." However, this evidence is not persuasive. Applicant's promotional efforts may be indicative of applicant's attempts to convince the public that GEAR is a mark, but not the success of those attempts. Moreover, applicant's sales may reflect the popularity of the products themselves rather than the purchasers' recognition of GEAR as a mark.<sup>24</sup> See *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) and *In re Leatherman Tool Group Inc.*, *supra*.

Furthermore, applicant's ownership of an existing registration for GEAR ROLLER HOCKEY in a "toothed disk" design is of no persuasive value in determining whether the term "GEAR" either by itself, or with different wording, or on a different background design is inherently distinctive. The presumption of validity of a registered mark, including the presumption that the subject mark is inherently distinctive for the identified goods, does not extend to individual components of the mark, let alone

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<sup>24</sup> For example, although one of applicant's "GEAR" designations appears in a Kryptonics advertisement, since the focus of the advertisement is not the "GEAR" designation, it is not evidence of that company's recognition of GEAR as a mark.

disclaimed, and therefore admittedly descriptive components of the mark. See *In re National Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 752 (Fed. Cir. 1985) ["The registration affords prima facie rights in the mark as a whole, not in any component." (Emphasis in original.)]; and See also *Kellog Co. v. Pack 'Em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed Cir. 1991) and *In re Dura Corporation*, 189 USPQ 210 (TTAB 1975). Under the circumstances, the registration provides no evidence of the validity of the present mark or any portion of the mark.<sup>25</sup> See also, *Goodyear Tire & Rubber Co. v. Vogue Tyre & Rubber Co.*, 47 USPQ2d 1748 (TTAB 1998).

Applicant's claims regarding the perception of the word GEAR as a "mechanical gear" are wholly unsupported on this record. Applicant maintains that GEAR would be perceived in this manner "[w]hether or not [the "mechanical gear" design] is part of the mark." (Applicant's brief, p.20.) First, the connotation of a mark is not determined in the abstract but in relation to the goods for which registration is sought. See, for example, *In re Abcor Development Corp., Inc.*, 588 F.2d 811, 200 USPQ 215 (CCPA

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<sup>25</sup> Applicant, citing *In re American Sail Training Association*, 230 USPQ 879 (TTAB 1986), appears to argue that in view of the existence of applicant's prior registration for GEAR and design, the Office is estopped "from refusing to register" the word GEAR in this application. For the above reasons, applicant's argument is without merit and applicant's reliance on that case is misplaced.

1978). The connotation of GEAR in relation to applicant's hockey products is "equipment" not machine parts. Moreover, there is nothing in the present mark which would evoke the image of a mechanical gear or any meaning other than the one typically associated with this word in relation to the identified goods. Certainly, the mere existence of a registration for the "toothed disk" design, even if that mark is strong and well known, cannot, in itself, establish that purchasers will perceive the word "gear" in a totally different context, that is, without the accompanying disk design, as a "mechanical gear."

We conclude that the record as a whole establishes that GEAR is perceived as a generic term for applicant's goods. Thus, the generic word GEAR in association with the generic word HOCKEY on a non-distinctive background design, is incapable of identifying applicant's goods and distinguishing them from those of others. Given the generic meaning of GEAR, the recognition of the term as a trademark by a small group of people must be deemed no more than a de facto recognition, entitled to no legal effect. See, *In re Recorded Books*, supra, and cases cited therein; and *In re Audio Books Inc.*, supra.

We turn then to the question of whether the wording GEAR HOCKEY is generic. Applicant maintains that the words comprise a unitary expression having no generic meaning. We disagree. First, we do not believe that GEAR HOCKEY would be perceived as a

unitary phrase. A mark is unitary if it creates a single, distinct commercial impression. See *Dena Corp. v. Belvedere International, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991). The commercial impression is determined by factors including the visual characteristics of the mark and the meaning of the terms in the mark in relation to each other. See *Dena Corp. v. Belvedere International, Inc.*, *supra* and *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213 (TTAB 2000). Visually, the word HOCKEY is situated directly under and physically connected to the word GEAR. However, the word HOCKEY is considerably smaller in size and prominence and it is also shown in a different style of lettering, all of which serves to separate the two words rather than to join them. Further, although each word GEAR and HOCKEY has a distinct meaning, the combined term, GEAR HOCKEY, makes no sense as a unitary phrase. See, e.g., *In re Taylor & Francis [Publishers] Inc.*, *supra*. The lack of any coherent meaning in the phrase as a whole further reinforces the perception of GEAR HOCKEY as two separate words. See also, e.g., *Dena Corp.*, *supra* at 1052 ["...mere proximity of EUROPEAN FORMULA to the unrelated design feature does not endow the whole with a single, integrated, and distinct commercial impression."]. We also note that applicant has submitted no evidence that the term GEAR HOCKEY is promoted as a unitary phrase or that purchasers would perceive the term as a phrase.

Thus, we find that GEAR HOCKEY does not create a unitary impression, and that instead, each word retains its individual generic meaning.

Even assuming GEAR HOCKEY to be unitary, we would still find that the phrase, as a whole, is generic. While as applicant points out, a purchaser would probably not use the wording "gear hockey" to request the goods, the question is, as always, how that term would be perceived by purchasers and what they would understand that phrase to mean when it is viewed under normal marketing conditions. Based on the evidence in this case, we have no doubt that the public understands the generic meaning of both the phrase "hockey gear" and the individual words "hockey" and "gear" in relation to applicant's goods. Reversing the order of these words does not result in a new term with a different meaning but rather just an awkward combination of two familiar terms. The term as a whole still signifies "gear for hockey" no matter how the two words are arranged.

Although we have determined that GEAR is generic, for purposes of a complete record, we will decide the issue of whether the mark is descriptive and applicant's alternative claim that the mark has acquired distinctiveness.

If GEAR is not generic, then the term is certainly highly descriptive. When considered in relation to applicant's goods, purchasers would immediately, and without the exercise of any

imagination, understand that the nature of applicant's goods are clothing and equipment used in the sport of hockey. The burden is on applicant to show acquired distinctiveness, and the more descriptive the term, the heavier that burden. *Yamaha International Corp. v. Hoshino Gakki Co.*, *supra*. In considering all of the evidence, and the highly descriptive nature of this term, we find that applicant has not met this burden.

First, the evidence of acquired distinctiveness must relate to the specific mark for which registration is sought. See *In re K-T Zoe Furniture Inc.*, 16 F.3d 398, 29 USPQ2d 1787 (Fed. Cir. 1994) and *In re Failure Analysis Associates*, 1 USPQ2d 1144 (TTAB 1986). As we noted earlier in this decision, applicant has submitted no evidence whatsoever bearing on the distinctiveness of either the mark as a whole or the background design itself, apart from any wording. Moreover, to the extent that applicant is seeking registration under 2(f) (in part) as to the word "gear" alone, or even if we consider the background design so insignificant that proof of acquired distinctiveness as to the entire mark is not required, the evidence still falls short.

Applicant may be attempting to base its claim of acquired distinctiveness of either the entire mark or the word "gear," alone, on its ownership of the registration identified in its application. Either way, the evidence fails because the applied-

for mark is not the "same mark," that is, the "legal equivalent" of the mark in the claimed registration.

Trademark Rule 2.41 provides that, in appropriate cases, "ownership of one or more prior registrations on the Principal Register...of the same mark may be accepted as prima facie evidence of distinctiveness." As set forth in *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001), a proposed mark is the "same mark" as a previously-registered mark for the purpose of Trademark Rule 2.41(b) if it is the "legal equivalent" of such mark. A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark. See *In re Dial-A-Mattress Operating Corp.*, supra. Therefore, a minor difference in the marks, such as mere pluralization or an inconsequential modification or modernization of the later mark, would not preclude a finding that the marks are legal equivalents. See *In re Loew's Theatres, Inc.*, 223 USPQ 513 (TTAB 1984) aff'd, 769 F.2d 764 (Fed. Cir. 1985) and *In re Flex-O-Glass, Inc.*, supra. On the other hand, the fact that two marks may be confusingly similar does not necessarily mean that they are legal equivalents. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, supra, and *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993). In this case, the two marks are not legal

equivalents as they contain striking visual differences and clearly do not convey the same meaning or commercial impression.

We also find that applicant's evidence of acquired distinctiveness based on actual use of its "gear related marks" is insufficient to show that GEAR has acquired distinctiveness. While applicant is correct that a showing of acquired distinctiveness can be based on evidence of less than five years use, as noted above, the sufficiency of the evidence is based on the nature of the mark and the conditions surrounding its use. See *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996 (TTAB 1986). As the Board in that case pointed out, while some terms may acquire such significance in a relatively short period of time, sometimes even less than five years, others, depending on the nature of the mark, require longer use and may never acquire distinctiveness no matter how long they have been used. In this case applicant's "gear related marks" have been in use for a very short period of time, only three years as of the date the application was filed, with \$3 million in sales for the entire three-year period, and two years of promotional expenditures totaling \$300 thousand. In addition, the specific "gear related marks," to which these figures apply, have not been identified. For example, applicant does not indicate whether some or any portion of its advertising expenditures relate to



promotion of the "oval toothed" design which does not even contain the word "gear."

Even if we consider the sales volume and advertising expenditures to be substantial for this short period of time, this evidence is still insufficient to establish acquired distinctiveness. There is no proof that the commercial success of applicant's products, such as it is, is due to recognition of GEAR as a mark, as opposed to the popularity of the equipment or even the fact that there are so few companies from which to purchase at least "high-end" hockey equipment. There is also no proof that the efforts made by applicant to achieve acquired distinctiveness, including applicant's promotional activities and expenditures and its other evidence of public exposure to "gear related marks," have been successful. See *In re Recorded Books Inc.*, *supra*.

Acquired distinctiveness is an association in the consumer's mind between the mark and the source of the goods or services.<sup>26</sup> While we can assume from applicant's evidence of use as well as its declarations of purchaser recognition of the term as a mark, that a few people have actually come to associate GEAR with the source of applicant's goods, the evidence is far from sufficient to establish that the average purchaser makes this association.

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<sup>26</sup> See, for example, *In re Brass-Craft Manufacturing Co.*, 49 USPQ2d 1849 (TTAB 1998) citing *In re Semel*, 189 USPQ 285 (TTAB 1975).

See Roselux Chemical Co. v. Parsons Ammonia Co., 299 F.2d 855, 132 USPQ 627 (CCPA 1962) ["... proof of distinctiveness requires more than proof of the existence of a relatively small number of people who associate the asserted mark with the producer."]. See also In re Audio Books Inc., supra and In re Recorded Books Inc., supra.

Therefore, assuming that GEAR could function as a mark, in view of the highly descriptive nature of that term, far more evidence than we have of record would be required to show that the term has acquired distinctiveness. See In re Recorded Books Inc., supra; and, e.g., In re Andes Candies Inc., 478 F.2d 1264, 178 USPQ 156, 158 (CCPA 1973) ["Because of long use, large sales and advertising, it may be assumed that some persons might recognize a mark as designating origin, but that alone is not enough."]; and In re Pennzoil Products Co., supra [applicant's 36 years and very substantial advertising and sales, product revenues and position of sales leadership in motor oil declarations from nine of applicant's customers, fail to prove that the term "MULTI-VIS" is either promoted as a trademark or perceived as one by the purchasing public].

**Decision:** The refusal to register is affirmed.